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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/425,766	04/19/95	GREENE	R 017220.0115

BAKER & BOTTS
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34M1/1028

EXAMINER	
TINKER, S	
ART UNIT	PAPER NUMBER
3404	#8

DATE MAILED: 10/28/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/425,766

Applicant(s)

Greene et al

Examiner

Susanne C. Tinker

Group Art Unit

3404



☒ Responsive to communication(s) filed on Apr 19, 1995

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3404

This application is objected to under 35 U.S.C. 251 as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 3.73(b). When the assignee of the entire right, title, and interest first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. 37 CFR 3.73(b). The assignee's ownership may be established either

(1) by submitting to the Office copies of the documentary evidence of a chain of title from the original inventor to the assignee, or

(2) by specifying, by reel and frame number, for example, where such documentary evidence is recorded in the Office.

(See MPEP § 324.) The assent of the assignee to reissue, filed April 19, 1995, fails to establish ownership as set forth in (1) or (2) above.

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 CFR 1.175(a)(5). Included are inadvertent errors in conduct, i.e., actions taken by the applicant, the attorney or others, before the original patent issued, which are alleged to be the cause of the actual errors in the patent. This includes how and when the errors in conduct arose or occurred, as well as how and when these errors were discovered.

Serial Number: 08/425,766

-3-

Art Unit: 3404

Applicant's attention is directed to *Hewlett-Packard v. Bausch & Lomb*, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989). Specifically, the applicant has failed to include how and when the error of the inclusion of the liquid filter element in claim 1 and claim 15 was discovered. For example, the declaration should indicate when and the manner in which the reissue applicant became aware of the prior art or other information and of the error in the patent.

Claims 1-20 rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanne Tinker whose telephone number is (703) 308-2637.


SCT

October 22, 1996


HENRY A. BENNETT
SUPERVISORY PRIMARY EXAMINER
GROUP 3400